

REMARKS

The Office Action of July 1, 2008 presents the examination of claims 1-19. Claims 1 and 10 are amended herein; all of claims 1-19 remain pending.

The amendments to claim 1 are supported by the specification based on the description on page 3, line 33 to page 4, line 7 and page 14, line 34 to page 15, line 26. The amendments to claim 10 are supported by the description on page 7, line 31 to page 13, line 15.

Rejection under 35 USC § 112, second paragraph

Claims 1-19 are rejected under 35 USC § 112, second paragraph as allegedly being indefinite in the recitation of “using a physically developed metal silver as a catalytic nucleus”. The claims are amended to remove this phrase, thus obviating this rejection.

Rejection over prior art

Claims 1 and 10 are rejected under 35 USC § 102(b) as being anticipated by JP ‘745. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Examiner asserts that JP ‘745 establishes that it was known in the art at the time the present invention was made to “make and use substrates with silver as a catalytic nucleus.” However, such a glib reading of the claims overlooks the substantial recitations in the claims.

First, although it is true that claim 1 is a “product by process” claim, claim 10 is a claim to a process *per se*. The Examiner cannot ignore the particular steps recited in the claim. Second, even though claim 1 is a product by process claim, the process steps recited result in a product that is substantially different from the article described in JP ‘745.

An English translation of JP ‘745 is provided herewith for the Examiner’s convenience. In the translation,

the term “Å” at page 2, line 2 is an abbreviation for the term “angstrom”;

the term “MΩ” on page 4, line 19 is an abbreviation for the term “mega-ohm”;

the term “mg” on page 4, line 21 is an abbreviation of “milligram”;

the term “Tetron” on page 6, lines 3 and 9, and pages 7 and 8, at several portions

is the Japanese trade name of the material known as “Dacron” in the U.S.; the term “cc” mentioned on page 8, lines 25 to 30 and 33 is the same as “cm³"; the term “g” mentioned on page 8, lines 28, 34 and 35 is an abbreviation of the word “gram”; the term “mA” on page 8, lines 9 and 11 is an abbreviation of the word “milliampere”.

Applicants submit that the reference cited describes an object having a “high resistance” ranging up to 10⁵ times higher than in claim 2 (page 5, lines 1-8 of the translation). On the other hand, the present invention described in claim 1 is a product having conductive properties (page 3, lines 2-3 of the specification). Such conductive properties (*i.e.*, low surface resistance) result from the “process steps” in claim 1, as shown by the working examples beginning at page 14 of the specification.

As to claim 10, review of the reference will show that there is no step described in the reference of plating a metal onto a physically developed metal resident on a substrate. In contrast, claim 10 recites such as step (“d”). Thus claim 10 is not anticipated by JP ‘745.

Since the present invention as recited in claims 1 and 10 is demonstrably different from the articles and processes described in JP ‘745, the instant rejection should be withdrawn.

Applicants submit that the present claims 1-19 clearly describe subject matter patentable over the prior art. The favorable actions of withdrawal of the standing rejections and allowance of the present application are requested.

Should there be any minor matters precluding allowance that can be resolved by a telephone conversation, the Examiner is invited to call the undersigned at 858-756-5959 to discuss them.

Entry of the above amendments is earnestly solicited. An early and favorable first action on the merits is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: November 6, 2008

Respectfully submitted,

By Mark J. Nuell
Mark J. Nuell
Registration No.: 36,623
BIRCH, STEWART, KOLASCH & BIRCH, LLP
12770 High Bluff Drive, Suite 260
San Diego, CA 92130
858-792-8855
Attorney for Applicant